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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,955	11/30/2000	Satoshi Tsujii	450100-02888	1116

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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

CHEVALIER, ROBERT

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 08/11/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

2

Office Action Summary

Application No.

09/726,955

Applicant(s)

TSUJII ET AL.

Examiner

Bob Chevalier

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/30/00.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-16 is/are rejected.
- 7) ☒ Claim(s) 10 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 8-9, 14, are rejected under 35 U.S.C. 102(b) as being anticipated by the submitted prior art of Park et al (EP 0932158 A2).

Park et al discloses a recording/reproducing apparatus that shows all the limitations recited in claims 1, and 14, including the feature of compression-encoding an input moving picture sequence (See Park et al's Figure 1, components 3-4), the feature of recording the compression-encoded data generated by the encoding means to a record medium (See Park et al's Figure 1, components 6-7, and 1), and the feature of extracting a plurality of pictures from the input moving picture sequence at irregular intervals and generating reduced pictures with the extracted pictures while compression-encoded data is being recorded to the record medium as specified in the present claims 1, and 14. (See Park et al's Figure 1, components 10-11, and 14-15, and further, see Park et al's column 11, section [0077], to column 12, section [0080], where it is disclosed that the extracted pictures are intracoded pictures; it is to be noted that I pictures are compressed pictures, as a result they are reduced pictures as claimed and as is well known in the compressing-encoding video art).

With regard to claim 8, the feature extracting the plurality of pictures from the moving picture sequence at irregular intervals starting from the first picture as specified

Art Unit: 2616

thereof is present in the cited reference Park et al. (See the interruption process described at column 12, section [0085], to column 13, section [0089]).

With regard to claim 9, the feature of selecting one picture at each change point of the input moving picture sequence as specified in the present claim 9 would be inherently present in the cited reference of Park et al. Because, Park et al discloses that the I picture of the program is selected corresponding to the user chosen interruption process of the main recording operation. (See Park et al's column 11, section [0077], to column 13 [0089]).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the submitted prior art of Park et al in view of Official Notice.

Park et al discloses a video recording/reproducing apparatus that shows substantially the same limitations recited in claim 2, including the feature of inputting moving picture sequence and recording the same on the recording medium as specified in the present claim 2. (See Park et al's Figure 2, components 1, 3-7).

Park et al fails to specifically disclose the feature of the inputted moving picture sequence being generated from a photographing means as specified in the present claim 2.

Examiner takes Official Notice in that it is notoriously well known in the recording art to have inputted moving picture sequence recorded on a recording medium being generated from a photographing means as specified in the present claim 2.

It would have been obvious to one skilled in the art to modify the Park et al's recording/reproducing apparatus wherein the inputting means provided thereof would incorporate the capability of inputting moving picture sequence from a photographing means and recording the same on the recording medium in the same conventional manner as is well known in the recording/reproducing art. Examiner has taken Official Notice. The motivation is to be able to record on the recording medium photographed images generated from a camera at any desired time as suggested in the prior art.

6. Claim 3-7, 12-13, and 15-16, are rejected under 35 U.S.C. 103(a) as being unpatentable over the submitted prior art of Park et al in view of Kuchta et al.

Park et al discloses a moving video recording/reproducing apparatus that shows substantially the same limitations recited in claims 3, and 15-16, including the feature of generating reduced pictures as specified in the present claims 3, and 15-16. (See Park et al's Figure 1, components 10-11, and 14-15, and further, see Park et al's column 11, section [0077], to column 12, section [0080]).

Park et al fails to specifically disclose the feature of compression-encoding the reduced pictures as specified in the present claims 3, and 15-16.

Kuchta et al does disclose a camera apparatus which includes the capability of recording compressed-encoded reduced picture on a recording medium as specified in the present claims 3, and 15-16. (See Kuchta et al's Figure 1B).

It would have been obvious to one skilled in the art to modify the Park et al's apparatus wherein the encoding means provided thereof would incorporate the capability of encoding the reduced pictures before recording the same on the recording medium in the same conventional manner as shown by Kuchta et al. The motivation is to increase the recording density of the recording medium as suggested in the prior art.

With regard to claims 4, and 7, the feature of while the compression-encoded data is being recorded to the recording medium, the reduced pictures are generated and the generated reduced pictures are compressed as specified thereof would have been present in the proposed combination of Park et al and Kuchta et al indicated above. Since, said proposed combination would include the capability of compressed-encoding the generated reduced pictures. (See the above rejection of claim 3, and further, see Park et al's column 11, section [0077], to column 12, section [0080]).

With regard to claims 5-6, the feature of recording on the recording medium the compressed-encoded reduced pictures as specified thereof would be present in the proposed combination of Park et al and Kuchta et al indicated above. (See Park et al's Figure 2, components 14, 15, 5-7, and 1).

With regard to claims 12-13, the feature of the encoding means having a memory for storing the moving picture and the reduced picture as specified thereof would be inherently present in the proposed combination of Park et al and Kuchta et al. Because, Park et al discloses an MPEG encoding means shown in Figure 2, component 4, for the purpose of encoding the inputted moving pictures; and that, one of ordinary skill in the art would readily recognize that conventional MPEG encoding means would necessarily include a memory means for the purpose of storing the inputted picture information.

7. Claims 10-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 703-305-4780. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Thai Tran can be reached on 703-305-4725. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bob Chevalier
August 7, 2004.


ROBERT CHEVALIER
PRIMARY EXAMINER